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Date of Deposit February 12, 2004

PATENT
Attorney Docket No.: 016355-002440US

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

NIKOLCHEV, JULIAN N., et al.

Application No.: Unassigned

Filed: Herewith

For: CONTRACEPTIVE
TRANSCERVICAL FALLOPIAN TUBE
OCCLUSION DEVICES AND THEIR
DELIVERY

Customer No.: 20350

Confirmation No.: Unassigned

Examiner: Unassigned

Technology Center/Art Unit: 3764

REQUEST FOR INTERFERENCE
WITH APPLICATION NO. 10/272,840
UNDER 37 C.F.R. §1.604 AND M.P.E.P.
§2304 AND PRELIMINARY
AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Prior to examination of the above-referenced application, please enter the
following remarks.

REMARKS

Claims 1-5 filed herewith correspond to and have been copied from claims 44, 45,
47, 51, and 59 of U.S. Patent Application No. 10/272,840, respectively. Claims 6 and 7 filed
herewith substantially correspond to independent claim 44 of U.S. Patent Application No.
10/272,840.

Applicants respectfully request that an Interference be declared under 37 C.F.R. §1.604 between the present application and U.S. Patent Application No. 10/272,840, filed October 16, 2002, in the name of Callister et al. and entitled "Contraceptive System and Method of Use," which was published as U.S. Patent Application Publication No. US 2003/0029457 on February 13, 2003 (hereinafter the '840 application).

The effective filing date of the present application is earlier than that of the '840 application, so that Applicants will be senior party in the requested interference. The present application is a continuation of U.S. Patent Application No. 09/591,874 (filed June 12, 2000), which was a continuation of U.S. Patent Application No. 08/474,779 (filed June 7, 1995), now U.S. Patent No. 6,176,240. Copies of each of the above-mentioned applications, as filed, are attached for the Examiner's convenience. Support for the Proposed Count is found in Applicants' originally filed parent application 08/474,779. In contrast, the '840 application was filed on October 16, 2002 and claims benefit of priority as a continuation of U.S. Patent Application No. 08/770,123 filed on December 18, 1996. Based on these relative dates, Applicants' effective filing date of June 7, 1995 is well before the '840 application's effective filing date of December 18, 1996. Accordingly, Applicants should be designated as the senior party for the requested interference.

Showing in Support of Requested Interference

Under M.P.E.P. §2304 and 37 C.F.R. §1.604, Applicants request this interference be declared between the present application and the '840 application. Applicants have satisfied each requirement of §1.604, which is reproduced in its entirety for the Examiner's convenience:

Sec. 1.604 Request for interference between applications by an applicant.

- (a) *An applicant may seek to have an interference declared with an application of another by, (1) Suggesting a Proposed Count and presenting at least one claim corresponding to the Proposed Count or identifying at least one claim in its application that corresponds to the Proposed Count, (2) Identifying the other application and, if known, a claim in the other application which*

corresponds to the Proposed Count, and (3) Explaining why an interference should be declared.

(b) When an applicant presents a claim known to the applicant to define the same patentable invention claimed in a pending application of another, the applicant shall identify that pending application, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where it appears an applicant may have failed to comply with the provisions of this paragraph.

(1.) Per Rule 1.604(a), Applicants are seeking to have an interference declared with the '840 application, which is assigned to Ovion, Inc. As the present application is assigned to Conceptus, Inc., the '840 application is the application "of another" under Rule 1.604(a).

(2.) Per 1.604(a)(1), the Proposed Count is as follows:

The Count

i) A contraceptive device, comprising an intraluminal body which is at least in part radially expandable about a longitudinal axis thereof within a lumen of a patient's reproductive system from a first transverse dimension to a second larger transverse dimension and which is provided with a deliverable contraceptive agent;

or

ii) A contraceptive device comprising a body expandable within a lumen of a patient's reproductive system from a first tubular configuration to a second tubular configuration, the second tubular configuration having a larger cross-sectional profile than the first tubular configuration relative to an axis of the contraceptive device, the contraceptive device comprising a contraceptive material.

The Proposed Count is a phantom count having a first part (i) corresponding exactly to claim 44 of the '840 application, as that claim was added in a preliminary amendment

filed for the '840 application on October 16, 2002. A second part (ii) of the Proposed Count corresponds exactly to claim 6 of the present application, a claim substantially corresponding to claim 44 of the '840 application, as added on October 16, 2002.

Applicants have presented in the present application claims 1-7, all of which correspond to the Proposed Count. Claim 1 of the present application corresponds exactly with the first part (i) of the count. Claim 6 of the present application corresponds exactly with the second part (ii) of the Proposed Count. Claims 2-5 and 7 of the present application substantially correspond to the Proposed Count. As noted above, claims 1-5 of the present application are identical to and have been copied from claims 44, 45, 47, 51, and 59 of the '840 application, respectively. Claims 6 and 7 of the present application substantially correspond to independent claim 44 of the '840 application.

- (3.) Per Rule 1.604(a)(2), the other application is U.S. Patent Application No. 10/272,840, filed on October 16, 2002 in the name of Callister et al. and entitled "Contraceptive System and Method of Use," which was published as U.S. Patent Application Publication No. US 2003/0029457 on February 13, 2003 (the '840 application). All claims (1 and 44-67) of the '840 application, as pending on February 13, 2003, correspond to the Proposed Count. Claim 44 of the '840 application corresponds exactly with the first part (i) of the Proposed Count. Claims 1 and 45-67 substantially correspond with the Proposed Count, since each would have been obvious in view of the Proposed Count. Moreover, there is no indication that any of the claims in the '840 application define a separately patentable invention. Per 37 C.F.R. §1.603 "[a]ll claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count."
- (4.) Per Rule 1.604(a)(3), an interference should be declared to prevent two patents from issuing with claims directed to the same patentable invention. Through publication of the pending '840 application, Applicants have learned that the claims of the '840 application are directed to Applicants' invention. As

Applicants originally filed our application for this invention on June 7, 1995, and as the '840 application was not originally filed until December 18, 1996, Applicants also seek to prevent the U.S. Patent Office from issuing a patent under an application which was not filed until a year and a half after we first filed for patent protection of this subject matter.

- (5.) Per Rule 1.604(b), claims 1-5, as presented herein, correspond exactly with claims 44, 45, 47, 51, and 59 of the '840 application, as those claims were pending in the preliminary amendment filed for the '840 application on October 16, 2002. Claims 6 and 7, as presented herein, correspond substantially with claim 44 of the '840 application as that claim was pending in the preliminary amendment filed for the '840 application on October 16, 2002.

As a final matter, Applicants note that §2304 of the M.P.E.P. states that: "If the applicant presents a new claim to provide an interference with a published application, the examiner should determine whether the new claim is barred under 35 U.S.C. §135(b)(2)." 35 U.S.C. 135(b)(2), in turn, states that: "A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published." As the '840 application was published on February 13, 2003, and as the present preliminary amendment and request have been filed prior to February 13, 2004, claims 1-7 of the present application have been filed within the one-year deadline of M.P.E.P. §2304 and 35 U.S.C. §135(b)(2).

Appl. No.
Amdt. dated February 12, 2004
Preliminary Amendment

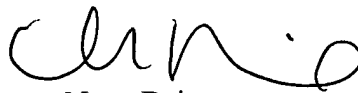
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CONCLUSION

In view of the foregoing, Applicants respectfully request that the Examiner declare an Interference with the '840 application.

If the Examiner believes a telephone conference would expedite this request, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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